

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gene A. Bornzin **Confirmation No.:** 9340
Serial No.: 10/667,112 **Examiner:** Johnson, S.E.
Filed: 09/17/2003 **Art Unit:** 3766
Docket No.: A03P1063
For: ENSEMBLE AVERAGING FOR EVOKED RESPONSES

SUBMISSION OF NEW DECLARATION AND REMARKS

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being e-filed with the
United States Patent and Trademark Office on:

September 5, 2007

Melinda E. Hallmark Date

Sir:

In the Notice of Allowability mailed June 8, 2007, the Examiner rejected the inventor declaration. Submitted herewith is a new declaration to overcome the rejection; however Applicants respectfully disagree with the rejection for the following reasons.

The Examiner alleges the inventor declaration is defective because the declaration states that the inventor acknowledges a duty to disclose information which is material "to the examination of the application" rather than information material "to patentability" as defined in Section 1.56. Applicants respectfully disagree with the Examiner's rejection of the inventor declaration.

Applicants submit that 37 CFR section 1.63 (see Exhibit A) previously required an acknowledgement of Applicant's duty to disclose information that is "material to the examination of the application". However, in a "Duty of Disclosure" rule change published at 1135 OG 13 (February 4, 1992), Rule 63 was changed so that its language tracked the "material to patentability" language of Rule 56 (See Exhibit B).

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In making this change, and in reply to Comment 38 at 1135 OG 17 (see Exhibit C), the Office stated the averments in oath or declaration forms presently in use that comply with the previous section 1.63 or 1.175 will also comply with the requirement of the new rules. The Office also stated, "Therefore, the Office will continue to accept the old oath or declaration forms as complying with the new rules." Applicants therefore submit that the inventor declaration, which complies with the requirements of Rule 63 prior to the 1992 rule change, also complies with the requirements of the current rule and should be accepted.

Moreover, the first page of the Duty of Disclosure Rulemaking (see Exhibit B) as published at 1135 OG 13 (February 4, 1992) explains that an Applicant for a patent also has a duty of candor and good faith in dealing with the Patent Office and that this duty is broader than the duty to disclose information material to patentability. Therefore, Applicants submit that the duty to disclose information material to the "examination" of the application (which includes the duty of candor and good faith) as recited in the inventor declaration for the subject application is broader than and includes the duty to disclose information material to the patentability of the application as required by the Examiner.

Applicants therefore submit that the as filed inventor declaration encompasses a broader duty of disclosure and complies with the requirements of 37 CFR 1.63. However, in the interest of moving this case to issuance, Applicants hereby submit a new declaration with the language required by the Examiner.

Respectfully submitted,

9/10/12
Date



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